

01-26-2001

FORM PTO-1595
1-31-92U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Docket No. 247/264

REC



T

101593690

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original documents or copy thereof.

1. Name of conveying party(ies): El Torito Restaurants, Inc.

- ☐ Individual ☐ Association
☐ General Partnership ☐ Limited Partnership
☒ Corporation State: Delaware
☐ Other

Additional name(s) of conveying party(ies) attached?

☐ Yes ☒ No

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Dates: June 28, 2000

2. Name and address of receiving party:

Name: FRI-Admin Corporation

Internal Address: _____

City: _____ State: _____ Zip: _____

Street Address: 2701 Alton AvenueCity: Irvine State: CA Zip: 92606

- ☐ Individual(s) Citizenship
☐ Association
☐ General Partnership
☐ Limited Partnership
☒ Corporation State Delaware
☐ Other

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or Trademark number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Trademark Application No(s). 75/853,509

B. Trademark No(s).:

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Corrine M. Freeman, Esq.

Internal Address: LYON & LYON LLP
633 West Fifth Street, Suite 4700
Los Angeles, CA 90071-2066
 Phone: (213) 489-1600 or (949) 567-2300

6. Total number of applications and trademarks involved: 17. Total fee (37 CFR 3.41): \$40.00☒ Enclosed☒ Charge this Deposit Account if any additional fee is required8. Deposit Account Number: 12-2475**DO NOT USE THIS SPACE**

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Corrine M. Freeman

Corrine M. Freeman, Reg. No. 37,625

Date: Jan. 8, 2001Total number of pages including cover sheet: 17

OMB No. 0651-0011 (exp. 4/94)

Do not detach this portion

Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents and Trademarks**Box Assignments****Washington, D.C. 20231**

01/25/2001 AAHMED1 00000129 75853509

01 FC:481

40.00 UP

Public burden reporting for this sample cover sheet is estimated to average about 30 minutes per document to be recorded, including time for reviewing the document and gathering the data needed, and completing and reviewing the sample cover sheet. Send comments regarding this burden estimate to the U.S. Patent and Trademark Office, Office of Information Systems, PK2-1000C, Washington, D.C. 20231, and to the Office of Management and Budget, Paperwork Reduction Project, (0651-0011), Washington, D.C. 20503

TRADEMARK
REEL: 002219 FRAME: 0930

AGREEMENT

This Agreement (hereinafter the "Agreement"), is by and between El Torito Restaurants, Inc. (hereinafter "El Torito"), a Delaware corporation having an address of 2701 Alton, Irvine, California 92614, and FRI-Admin Corporation, (hereinafter "FRI"), a Delaware corporation having an address of 2701 Alton, Irvine, California 92614, and is effective as of the latest execution date reflected below.

WHEREAS, El Torito is the owner of the trademarks, service marks, trade dress, registrations and applications, and other intellectual property rights listed on the attached Schedule A (collectively hereinafter "ETX IP") and all goodwill of the business associated therewith.

WHEREAS, El Torito is the owner of the trademarks, service marks, registrations and applications, and other intellectual property rights listed on the attached Schedule B (collectively hereinafter "ET MARKS/IP") and all goodwill of the business associated therewith.

WHEREAS, FRI desires to acquire and El Torito is willing to assign all of El Torito's right, title, and interest in and to the ETX IP and the goodwill of the business associated therewith subject to the provisions of this Agreement.

WHEREAS, FRI also desires to receive and El Torito is willing to grant a royalty-free license subject to the provisions of this Agreement to use the ET MARKS/IP in perpetuity in

connection with the operation in the United States of its fast-food restaurant business which currently does business under the names El Torito Express and El Torito Express Grill (collectively hereinafter "EL TORITO EXPRESS").

WHEREAS, El Torito desires to receive and FRI is willing to grant a royalty-free license subject to the provisions of this Agreement to use and sub-license the ETX IP in perpetuity in connection with the operation outside the United States of its fast-food restaurant business which currently does business under the name EL TORITO EXPRESS.

NOW, THEREFORE, for good and valuable consideration transferred between FRI and El Torito, the receipt and adequacy of which are hereby acknowledged by each, FRI and El Torito agree as follows:

1. El Torito irrevocably transfers and assigns to FRI, all El Torito's right, title and interest in the above-identified ETX IP, together with the goodwill of the business associated therewith, and the right to sue for past, present and future infringement or other violation of any of the foregoing and the right to collect and own any monetary or other damages as a result thereof. El Torito shall execute and deliver to FRI any and all further documents or instruments and do any and all further acts which FRI (or its agents or designees) reasonably request in order to perfect, confirm and record FRI's rights in the ETX IP.
2. Subject to the provision of this Agreement, El Torito grants to FRI (and FRI accepts) a royalty-free license (with right of sublicense) to use the above-identified ET

MARKS/IP in perpetuity (subject to the provisions of paragraph 10.a. below) in connection with the operation in the United States of its fast-food restaurant business which currently does business under the name EL TORITO EXPRESS.

3. FRI agrees that the nature and quality of all services rendered by FRI and its sublicensees, in connection with any marks or other indicia of origin in the ET MARKS/IP, all goods sold by FRI and its sublicensees under such marks or other indicia of origin, and all related advertising, promotional and other related uses of such marks or other indicia of origin shall conform to the same or higher quality standards as previously provided and controlled by El Torito in connection with the ET MARKS/IP. El Torito shall have the right to enter the business premises of FRI and its sublicensees from time to time upon reasonable notice to FRI in order to ensure that FRI and its sublicensees are maintaining the quality of the goods and services sold and provided in connection with any marks or other indicia of origin in the ET MARKS/IP as required hereunder. Upon El Torito's reasonable request, FRI shall, at FRI's expense and to the extent possible, submit representative specimens or evidence of uses of any marks or other indicia of origin in the ET MARKS/IP by FRI and its sublicensees on advertising, promotional and other materials.

4. El Torito agrees that it shall make reasonable efforts to maintain any existing trademark or service mark registrations and diligently to prosecute all existing trademark or service mark applications in the ET MARKS/IP by making such filings and payments as may be required from time to time in connection therewith. FRI shall never claim ownership of or challenge El Torito's rights in the ET MARKS/IP, or seek to register, or maintain any registration for any

marks or other indicia of origin in the ET MARKS/IP or any marks or designations likely to be confused with any marks or other indicia of origin in the ET MARKS/IP, to the extent and for so long as El Torito's rights in such marks or other indicia of origin have not been abandoned or otherwise expired. FRI shall not use modified versions of any marks or other indicia of origin in the ET MARKS/IP without El Torito's prior, express permission in writing.

5.a. FRI agrees to notify El Torito of any violation or unauthorized use of the ET MARKS/IP by others promptly after it becomes aware of such violation or unauthorized use and El Torito agrees to take reasonable steps, by legal proceedings or otherwise, to protect and defend the ET MARKS/IP against such violations or unauthorized use. FRI shall provide such cooperation to El Torito in connection with such actions as El Torito may reasonably request (including, to the extent necessary, joining as a party in any legal proceedings). El Torito shall reimburse FRI for all reasonable costs and expenses (including reasonable attorneys' fees and disbursements) incurred by FRI in providing such cooperation. El Torito shall control and shall have the exclusive right to receive any and all amounts recovered in connection with such proceedings.

5.b. In the event that El Torito fails to take reasonable steps, by legal proceedings or otherwise, to protect and defend the ET MARKS/IP against a given violation or unauthorized use, then FRI shall have the right, without prejudice to any other rights it may have hereunder and in its sole discretion, to undertake, at its own expense and with the right to any and all amounts recovered in connection with such proceedings, any litigation or other action it may deem necessary or appropriate in connection with such violation or unauthorized use. El Torito shall provide such

cooperation to FRI in connection with such actions as FRI may reasonably request (including, to the extent necessary, joining as a party in any legal proceedings). FRI shall reimburse El Torito for all reasonable costs and expenses (including reasonable attorneys' fees and disbursements) incurred by El Torito in providing such cooperation.

6. Subject to the provision of this Agreement, FRI grants to El Torito (and El Torito accepts) a royalty-free license (with right of sublicense) to use the above-identified ETX IP in perpetuity (subject to the provisions of paragraph 10.b. below) in connection with the operation outside the United States of its fast-food restaurant business which currently does business under the name EL TORITO EXPRESS. The parties acknowledge that there are no pending, granted, or issued trademark applications or registrations outside the United States for any marks in the above-identified ETX IP at the present time.

7. El Torito agrees that the nature and quality of all services rendered by El Torito and its sublicensees, in connection with any marks or other indicia of origin in the ETX IP, all goods sold by El Torito and its sublicensees under such marks or other indicia of origin, and all related advertising, promotional and other related uses of such marks or other indicia of origin shall conform to the same or higher quality standards as previously provided and controlled by El Torito and as presently provided and controlled by FRI in connection with the ETX IP. FRI shall have the right to enter the business premises of El Torito's fast-food restaurant businesses which currently operate outside the United States under the name EL TORITO EXPRESS and any sublicensees of the same from time to time upon reasonable notice to El Torito in order to ensure that El Torito and its sublicensees are maintaining the quality of the goods and services

sold and provided in connection with any marks or other indicia of origin in the ETX IP as required hereunder. Upon FRI's reasonable request, El Torito shall, at El Torito's expense and to the extent possible, submit representative specimens or evidence of uses of any marks or other indicia of origin in the ETX IP by El Torito and its sublicensees on advertising, promotional and other materials.

8. a. FRI agrees that it shall make reasonable efforts to maintain any existing trademark or service mark registrations and diligently prosecute all existing trademark or service mark applications in the ETX IP by making such filings and payments as may be required from time to time in connection therewith. El Torito shall never claim ownership of or challenge FRI's rights in the ETX IP, or, except as expressly provided for herein, seek to register, or maintain any registration for any marks or other indicia of origin in the ETX IP or any marks or designations likely to be confused with any marks or other indicia of origin in the ETX IP, to the extent and for so long as FRI's rights in such marks or other indicia of origin have not been abandoned or otherwise expired. El Torito shall not use modified versions of any marks or other indicia of origin in the ETX IP without FRI's prior, express permission in writing.

8. b. Notwithstanding anything herein to the contrary, however, El Torito shall have the right at its discretion and sole expense to file and prosecute applications to register and to maintain any resulting registration for any marks or other indicia of origin in the ETX IP in those countries outside the United States in which it operates its business, provided that all such applications and registrations shall be filed and maintained in the name of FRI and shall be subject to the terms of the license of the ETX IP hereunder. At El Torito's sole expense, FRI

shall provide such cooperation, including, without limitation, signing and delivering such documents, to file, prosecute and maintain such applications and registrations as El Torito may reasonably request.

9.a. El Torito agrees to notify FRI of any violation or unauthorized use of the ETX IP by others promptly after it becomes aware of such violation or unauthorized use and FRI agrees to take reasonable steps, by legal proceedings or otherwise, to protect and defend the ETX IP against such violations or unauthorized use. El Torito shall provide such cooperation to FRI in connection with such actions as FRI may reasonably request (including, to the extent necessary, joining as a party in any legal proceedings). FRI shall reimburse El Torito for all reasonable costs and expenses (including reasonable attorneys' fees and disbursements) incurred by El Torito in providing such cooperation. FRI shall control and shall have the exclusive right to receive any and all amounts recovered in connection with such proceedings.

9.b. In the event that FRI fails to take reasonable steps, by legal proceedings or otherwise, to protect and defend the ETX IP against a given violation or unauthorized use, then El Torito shall have the right, without prejudice to any other rights it may have hereunder and in its sole discretion, to undertake, at its own expense and with the right to any and all amounts recovered in connection with such proceedings, any litigation or other action it may deem necessary or appropriate in connection with such violation or unauthorized use. FRI shall provide such cooperation to El Torito in connection with such actions as El Torito may reasonably request (including, to the extent necessary, joining as a party in any legal proceedings). El Torito shall

reimburse FRI for all reasonable costs and expenses (including reasonable attorneys' fees and disbursements) incurred by FRI in providing such cooperation.

10.a. El Torito shall have the right to terminate the license of the ET MARKS/IP granted to FRI hereunder on one hundred and twenty (120) days' written notice to FRI in the event that FRI or its sublicensees materially breach, materially violate or otherwise materially fail to comply with their obligations under this Agreement (including, without limitation, the quality control provisions set forth in paragraph 3), provided however, that if within that one hundred and twenty (120) day notice period, FRI and/or its sublicensees have reasonably cured or otherwise corrected such breach, violation or noncompliance, said notice of termination shall have no force and effect and this Agreement shall continue under all the terms and conditions as existed prior to said notice. In the event of such termination, the license of the ET MARKS/IP granted to FRI hereunder shall immediately and automatically cease and FRI and its sublicensees shall make no further use thereof.

10.b. FRI shall have the right to terminate the license of the ETX IP granted to El Torito hereunder on one hundred and twenty (120) days' written notice to El Torito in the event that El Torito or its sublicensees materially breach, materially violate or otherwise materially fail to comply with their obligations under this Agreement (including, without limitation, the quality control provisions set forth in paragraph 7), provided however, that if within that one hundred and twenty (120) day notice period, El Torito and/or its sublicensees have reasonably cured or otherwise corrected such breach, violation or noncompliance, said notice of termination shall have no force and effect and this Agreement shall continue under all the terms and conditions as

existed prior to said notice. In the event of such termination, the license of the ETX IP granted to El Torito hereunder shall immediately and automatically cease and El Torito and its sublicensees shall make no further use thereof.

11. Notwithstanding anything contained in other paragraphs of this Agreement to the contrary, either party shall be entitled to seek injunctive or other equitable relief in a court of valid jurisdiction in the event of any breach or other failure to comply with the provisions of this Agreement.

12. FRI shall indemnify and hold harmless El Torito for, from and against any and all costs, expenses, losses and damages (including, without limitation, any court costs and reasonable attorneys' fees and disbursements) incurred or arising from or otherwise concerning FRI's breach of this Agreement and/or use of the ET MARKS/IP by FRI, its sublicensees or successors in interest. El Torito shall indemnify and hold harmless FRI for, from and against any and all costs, expenses, losses and damages (including, without limitation, any court costs and reasonable attorneys' fees and disbursements) incurred or arising from or otherwise concerning El Torito's breach of this Agreement and/or use of the ETX IP by El Torito, its sublicensees or successors in interest.

13. EACH PARTY ACKNOWLEDGES AND ACCEPTS THAT THE RIGHTS ASSIGNED AND LICENSED HEREUNDER ARE ASSIGNED AND LICENSED ON AN "AS IS" BASIS AND THAT NEITHER PARTY MAKES ANY EXPRESS OR IMPLIED REPRESENTATIONS OR WARRANTIES OF ANY KIND TO THE OTHER PARTY WITH

RESPECT THERETO, INCLUDING, WITHOUT LIMITATION, WHETHER THE USE OF SUCH RIGHTS BY THE OTHER PARTY MAY INFRINGE OR OTHERWISE VIOLATE THE INTELLECTUAL PROPERTY OR OTHER RIGHTS OF ANY THIRD PARTY, AND THAT ANY IMPLIED WARRANTIES REGARDING SUCH RIGHTS ARE EXPRESSLY DISCLAIMED.

14. Neither party may assign or otherwise transfer any of its rights and obligations hereunder without the prior, written consent of the other party, except that either party may, without the consent of but on prior notice to the other party, assign or otherwise transfer its rights and obligations hereunder in connection with the sale of the business of the assigning party to which this Agreement pertains. Any assignment or other transfer in violation of this paragraph shall be deemed null and void. This Agreement shall inure to the benefit of and be binding upon the successors and permitted assigns of each party.

15. Any notice hereunder shall be in writing and shall be deemed to have been duly given if delivered or mailed (registered or certified, with proper postage and registration or certification fees prepaid), or sent by facsimile transmission (with confirmation), addressed to the party for whom intended as follows (or to such other address as each party or its successors in interest may provide to the other party or its successors in interest).

FRI-Admin Corporation
2701 Alton Avenue
Irvine, California 92614
Attention Legal Department
Telephone: (949) 852-5700
Facsimile: (949) 757-8076

El Torito Restaurants, Inc
2701 Alton Avenue
Irvine, California 92614
Attention Legal Department
Telephone: (949) 852-5700
Facsimile: (949) 757-8076

16. This Agreement and the respective rights and obligations hereunder of the parties hereto shall be governed by and interpreted and determined in accordance with the laws (other than laws regarding conflict or choice of laws) of the State of California applied to contracts made and performed therein.

17. This Agreement may be amended only by a written instrument executed by the parties hereto. The performance or observance of any term of this Agreement (whether generally or in a particular instance, whether retroactively or prospectively) may be waived only by a written instrument executed by the party to be bound thereby.

18. This Agreement may be executed simultaneously in any number of counterparts, each of which when so executed and delivered shall be deemed to be an original, but all of which counterparts shall together constitute but one agreement.

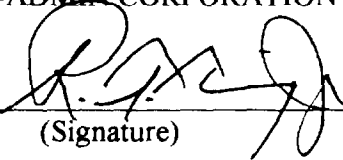
19. If any provisions of this Agreement shall be held invalid or unenforceable by any court of competent jurisdiction, such holding shall not invalidate or render unenforceable any other provision hereof.

20. This Agreement supersedes all prior agreements and understandings of the parties, oral or written, with respect to its subject matter.

IN WITNESS WHEREOF, FRI and El Torito have executed this instrument as of the date(s) indicated below.

FRI-ADMIN CORPORATION

Date: June 28, 2000

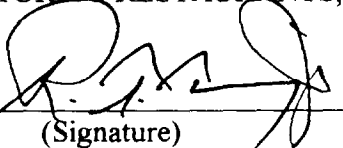
By 
(Signature)

Robert T. Trebing, Jr.
(Printed Name)

Its President
(Title)

EL TORITO RESTAURANTS, INC.

Date: June 28, 2000

By 
(Signature)

Robert T. Trebing, Jr.
(Printed Name)

Its Vice President
(Title)

SCHEDULE A

ETX IP

1. All rights which El Torito may have in and to any and all intellectual property (i.e., any and all patents and patent applications, industrial design rights, trademarks, service marks, trade names, trade dress, copyrights, mask works, trade secrets, inventions and technology (whether or not patentable), confidential and proprietary information, domain names, software, databases and other collections and compilations of data, rights of publicity/privacy, or other intellectual property) used exclusively in connection with the operation of the El Torito Express restaurants and not designated in Schedule B of this Agreement entitled "ET MARKS/IP" and/or including, but not limited to, the following names/marks, but expressly excluding any and all rights in the name and mark EL TORITO EXPRESS (or any variant thereof):

TASTES OF THE SOUTHWEST
EXPRESS SALSA GARDEN
WELCOME TO THE SOUTHWEST
TAKE THE SOUTHWEST WITH YOU

2. All rights which El Torito may have in and to all logos used exclusively in connection with the operation of the El Torito Express restaurants and not designated in Schedule B of this Agreement entitled "ET MARKS/IP" and/or including, but not limited to, the following logos/marks, but excluding any logos associated with the name and mark EL TORITO EXPRESS (or any variant thereof):

EXPRESS SALSA GARDEN AND CRATE DESIGN

3. The following U.S. Trademark Applications and Registrations:

U.S. App. Ser. No. 75/689,977 for EXPRESS SALSA GARDEN
U.S. App. Ser. No. 75/734,518 for EXPRESS SALSA GARDEN

U.S. App. Ser. No. 75/758,190 for TASTES OF THE SOUTHWEST

4. The following other intellectual property:

4.a. All rights which El Torito may have in any trade dress of the El Torito Express restaurants as of the date of this Agreement.

SCHEDULE B

ET MARKS/IP

1. All rights which El Torito may have in and to any and all menu item names offered in El Torito Express restaurants as of the date of this Agreement, including, but not limited to, the names shown on the menu examples attached as "Exhibit 1 to Schedule B", and/or including, but not limited to, the following names/marks:

ARBOL SALSA
BEAN AND CHEESE BURRITO
BREAKFAST BURRITO
BREAKFAST QUESADILLA
BREAKFAST TACO
BURRITO CLASSICO
CARNE ASADA TACO
CHICKEN CAESAR BURRITO
DESERT HEAT CRISPY TACOS
EXPRESS FAVORITES
EXPRESS GRILL TACO
FIRE ROASTED TOMATO SOUP
FRESH FISH TACO
GRILLED FISH BURRITO
GRILLED FISH TACO
GRILLED VEGETABLE BURRITO
GRILLED VEGETABLE TACO
HONEY BUTTER
JALAPENO BUTTER
MEXICAN RICE
NAVAJO NACHOS

PLATIVOS FESTIVOS
PUERTO NUEVO FISH BURRITO
PUERTO NUEVO FISH TACO
ROASTED CHILE DE ARBOL SALSA
SALSA QUEMADA
SALSA ROJA
SALSA VERDE
SAUTEED SHRIMP TACO
SHRIMP TACO
SOUTHWEST FAJITAS
SOUTHWESTERN CHICKEN CAESAR
BURRITO
SOUTHWESTERN CHICKEN CAESAR SALAD
SOUTHWESTERN POTATO CAKE
SOUTHWESTERN VEGETABLE BURRITO
SWEET CORN CAKE
TACO CLASSICO
TOSTADA GRANDE
VEGGIE BURRITOS
VEGETABLE FAJITAS
VEGETABLE TACO

2. All rights which El Torito may have in and to any and all photographs used in and/or associated with El Torito Express restaurants as of the date of this Agreement, including, but not limited to, the photographs shown on the menu examples attached as "Exhibit 1 to Schedule B", and/or including, but not limited to, the following photographs:

Photograph of platter of chicken burritos
Photograph of side dishes
Photograph of tacos
Photograph of soup

Photograph of platter of vegetable burritos
Photograph of platter of chicken salad

3. The following U.S. Trademark Applications and Registrations:

U.S. App. Ser. No. 75/642,999 for NAVAJO NACHOS
U.S. Reg. No. 1,582,816 for SALSA QUEMADA

4. The following other intellectual property:

All rights which El Torito may have in and to all recipes and methods of food preparation used in El Torito Express restaurants as of the date of this Agreement, including, but not limited to, the recipes and methods of preparing the menu items listed in this Schedule B, item 1, above.